

ESTTA Tracking number: **ESTTA412233**

Filing date: **06/01/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	De Beers Centenary AG
Granted to Date of previous extension	06/01/2011
Address	Alpenstrasse 5 6000 Luzern 6, SWITZERLAND

Attorney information	Brian R. McGinley SNR Denton P.O. BOX 061080 Chicago, IL 60606-1080 UNITED STATES trademarks@snrdenton.com,brian.mcginley@snrdenton.com,anita.hansen@snrdenton.com Phone:816-460-2605
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Applicant Information

Application No	85156888	Publication date	02/01/2011
Opposition Filing Date	06/01/2011	Opposition Period Ends	06/01/2011
Applicant	Sandberg & Sikorski Corporation 154 West 14th Street New York, NY 10011 UNITED STATES		

Goods/Services Affected by Opposition

Class 014. All goods and services in the class are opposed, namely: Jewelry
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3376133	Application Date	05/31/2006
Registration Date	01/29/2008	Foreign Priority Date	NONE
Word Mark	A DIAMOND IS FOREVER		

Design Mark	A DIAMOND IS FOREVER
Description of Mark	NONE
Goods/Services	<p>Class 014. First use: Jewellery, including diamond jewellery, and imitation jewellery; precious and semi-precious stones, including diamonds; horological and chronometric instruments</p> <p>Class 035. First use: Retail store services, wholesale ordering services, all of the foregoing in the field of precious metals and their alloys and goods in precious metals or coated therewith, jewellery, including diamond jewellery and imitation jewellery, precious stones including diamonds and semi-precious stones, horological and chronometric instruments</p>

Attachments	<p>78979644#TMSN.jpeg (1 page)(bytes) Forever - Notice of Opposition.pdf (8 pages)(130583 bytes)</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/brian r mcginley/
Name	Brian R. McGinley
Date	06/01/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of)
U.S. Application Serial No. 85/156,888)
Published in the Feb. 1, 2011 *Official Gazette*)
)
De Beers Centenary AG,)
)
Opposer,)
)
v.) Opposition No. _____
)
Sandberg & Sikorski Corporation,)
)
Applicant.)

NOTICE OF OPPOSITION

De Beers Centenary AG (“De Beers” or “Opposer”), a Swiss Aktiengesellschaft (AG) having offices at Alpenstrasse 5, Luzern 6, Switzerland, 6000, believes that it will be damaged by registration of the mark shown in Application Serial No. 85/156,888 and hereby opposes registration of same under § 13 of the Trademark Act of 1946, 15 U.S.C. § 1063. Opposer states the following in support of this Notice of Opposition.

Sandberg & Sikorski Corporation (the “Applicant”) filed an intent-to-use application under 15 U.S.C. § 1051(b) to register FOREVER for “jewelry” in Class 014, which was assigned Serial No. 85/156,888 and an October 20, 2010 filing date (the “Application”). The United States Patent and Trademark Office (“USPTO”) published the Application for opposition in the *Official Gazette* on February 1, 2011 allowing time to oppose said application up to and including, March 3, 2011. On March 3, 2011 Opposer filed a Request for Extension of Time to Oppose until June 1, 2011. The Trademark Trial and Appeal Board (“TTAB”) granted Opposer’s Request. Accordingly, Opposer has timely filed this Notice of Opposition.

De Beers' A DIAMOND IS FOREVER Mark

1. Opposer is, amongst other things, the intellectual property holding company of the De Beers Group of Companies (“The De Beers Group”).

2. Opposer owns and/or has the power and authority to enforce the intellectual property rights, including all trademark rights, of The De Beers Group, and therefore has standing to file this Notice of Opposition.

3. The De Beers Group is the world’s pre-eminent diamond producer. For more than a century, the name DE BEERS has been synonymous with diamonds.

4. The De Beers Group was established in 1888 and has been involved in all aspects of the diamond industry, including jewelry. It leads the world in diamond exploration, mining recovery, sorting, valuation and marketing.

5. Historically, The De Beers Group has sold a substantial percentage of the world supply of rough, gem-quality diamonds. By some estimates, De Beers Group sold eighty-five (85) to ninety (90) percent of the world’s supply of rough, gem-quality diamonds as recently as 1988 and sixty-five percent of the world’s supply as of the year 2000. Although in the past De Beers Group has not had a traditional business presence in the United States, it has nonetheless constituted the largest diamond mining businesses in the world throughout the better part of the twentieth century and it remains so today.

6. Through its sales and marketing arm, The Diamond Trading Company Limited (known in the trade as “the DTC”) based in London, the De Beers Group sorts, values and sells approximately two-thirds of the world’s annual supply of rough diamonds. Additionally, for almost sixty -five (65) years, the DTC has worked with The De Beers Group in conducting well-

known advertising and promotional campaigns for diamonds and diamond jewellery around the world.

7. For nearly sixty-five (65) years, Opposer and The De Beers Group have used the mark A DIAMOND IS FOREVER in connection with the mining, trade, distribution, promotion and sale of diamonds. Opposer further owns United States Trademark Registration No. 3,376,133 for A DIAMOND IS FOREVER in connection, *inter alia*, with “jewellery, including diamond jewellery, and imitation jewellery; precious and semi-precious stones, including diamonds; horological and chronometric instruments” in Class 014 and retail store services, wholesale ordering services in the fields of precious metals, jewelry including diamond jewellery, and precious and semi-precious stones.

8. Beginning at least as early as 1948, The De Beers Group have used the A DIAMOND IS FOREVER mark in commerce on or in connection with the mining, trade, distribution, promotion and sale of diamonds. By virtue of The De Beers Group’s extensive and continuous usage, coupled with substantial sales in commerce and significant promotional and advertising activities, The De Beers Group have achieved widespread recognition with the relevant trade and public of the A DIAMOND IS FOREVER mark for the mining, trade, distribution, promotion and sale of diamonds, creating a substantial and valuable goodwill among the relevant trade and public with respect to such mark.

9. Since The De Beers Group and its authorized business partners began using its A DIAMOND IS FOREVER mark approximately sixty-five (65) years ago on and in connection with its mining, trade, distribution, promotion and sale of diamonds and jewelry, such use clearly predates both the Applicant’ application filing date, October 20, 2010. Accordingly, priority is not an issue in this proceeding.

10. For example, in his book *Twenty Ads That Shook the World* (Crown Publishers 2000), James B. Twitchell named the “A DIAMOND IS FOREVER” advertising campaign as among the century’s most groundbreaking advertising and discussed the success of the advertising and promotion of diamonds and diamond jewelry by The De Beers Group’s advertising agencies.

Applicant and Its FOREVER Application

11. Applicant filed an intent-to-use application on October 20, 2010 to register the mark FOREVER for “jewelry” in International Class 014. The USPTO assigned Serial No. 85/156,888 and a October 20, 2010 filing date to the Application.

12. Applicant’s use of and/or registration of the FOREVER mark for the specified goods so resembles the Opposer’s A DIAMOND IS FOREVER mark as to be likely to create confusion, mistake, or deception under § 2(d) of the Trademark Act, 15 U.S. C. § 1052(d).

Count I: Likelihood of Confusion

13. Opposer re-alleges paragraphs 1-12 as though fully stated herein.

14. Applicant’s use of and/or registration of the FOREVER mark for the specified goods so resembles the A DIAMOND IS FOREVER mark as to be likely to create confusion, mistake, or deception under § 2(d) of the Trademark Act, 15 U.S. C. § 1052(d).

15. Applicant’s FOREVER mark is confusingly similar to and/or likely to cause confusion with Opposer’s A DIAMOND IS FOREVER mark. Consumers encountering Applicant’s FOREVER mark, in connection with Applicant’s jewelry goods, will be likely to falsely believe that such services are offered or otherwise sponsored or endorsed by, or otherwise affiliated with or endorsed by, Opposer and/or The De Beers Group.

16. Applicant's jewelry goods are overlapping with, substantially similar and/or identical to the products and services with which Opposer and the De Beers Group uses the A DIAMOND IS FOREVER mark.

17. As the Application herein opposed has no limitation on trade channels, Applicant's goods are presumed to be offered and provided in all of the ordinary and usual channels of trade for such jewelry products.

18. The De Beers Group has used and uses the A DIAMOND IS FOREVER mark on the Internet. The De Beers Group also owns and operates the domain name and website at www.adiamondisforever.com.

19. As the application herein opposed has no limitation on trade channels, it is likely that Applicant will use its proposed FOREVER mark on the Internet since it very common in today's globalized economy for sellers to use websites to advertise and sell their products and services. As a result, Applicant's use of its FOREVER mark on the Internet will overlap with The De Beer Group's use of their A DIAMOND IS FOREVER mark on the Internet, thereby further exacerbating the likelihood of confusion between the marks.

20. Applicant's goods advertised and sold under the FOREVER mark are or likely will be offered to and purchased by the same class of purchasers and will very likely be offered and sold in the same trade channels as the products offered by The De Beers Group under the A DIAMOND IS FOREVER mark since the goods are overlapping and identical.

21. At the time Applicant filed its trademark application to register the FOREVER mark, Applicant had constructive notice of the A DIAMOND IS FOREVER mark by virtue of Opposer's United States Trademark Registration.

22. The De Beers Group has established considerable goodwill in connection with the A DIAMOND IS FOREVER mark. Having established such goodwill, Opposer and The De Beers Group is entitled to protection against use and registration of confusingly similar marks.

23. If the Application mark becomes registered, purchasers are likely to believe that Applicant's mark and the goods offered thereunder originated with or are connected or associated with, or sponsored, licensed, endorsed or approved by Opposer and the De Beers Group, all to Opposer and the De Beers Group's detriment. Registration of the Application would allow Applicant to wrongfully appropriate Opposer's and The De Beers Group's valuable goodwill and reputation associated with the A DIAMOND IS FOREVER mark.

24. By reason of the foregoing, Opposer is likely to be harmed by registration of Application Serial No. 85/156,888 for the mark FOREVER.

Count II: Dilution

25. Opposer re-alleges Paragraphs 1-24 as though fully restated herein.

26. Opposer's A DIAMOND IS FOREVER mark has been used for approximately sixty-five (65) years in connection with the mining, trade, distribution, promotion and sale of diamonds offered and sold around the world and has become famous under 15 U.S.C. § 1125(c) among consumers in the U.S. and internationally and amongst the relevant consuming public. As a result, the A DIAMOND IS FOREVER is a famous mark under the Lanham Act.

27. Applicant's intent-to-use application to register FOREVER was filed after the A DIAMOND IS FOREVER mark became famous.

28. Registration of Applicant's FOREVER mark would be likely to cause dilution by blurring or dilution by tarnishment of the distinctive quality of the A DIAMOND IS FOREVER famous mark. The registration of Applicant's mark would lessen the capacity of the

A DIAMOND IS FOREVER mark to identify and distinguish goods and services exclusively from The De Beers Group.

29. Registration of FOREVER is likely to dilute the A DIAMOND IS FOREVER mark in violation of Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f) and 15 U.S.C. § 1063.

30. By reason of the foregoing, Opposer and The De Beers Group are likely to be harmed by registration of Application Serial No. 85/156,888 for the mark FOREVER.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's proposed FOREVER mark pray that the TTAB sustain this opposition and refuse to register Application Serial No. 85/156,888, with prejudice.

Opposer hereby appoints Brian R. McGinley and Rebecca S. Stroder and SNR Denton US LLP, P.O. Box #061080, Chicago, IL 60606-1080, as its domestic representatives and attorneys at law upon whom notices and process in proceedings affecting this proceeding may be served.

Respectfully submitted,

SNR Denton US LLP

Dated: June 1, 2011

By: /s/ Brian R. McGinley
Attorney for De Beers Centenary AG

Brian R. McGinley
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CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing NOTICE OF OPPOSITION to be served upon:

Donna Mirman Broome
GOTTLIEB, RACKMAN & REISMAN, P.C.
270 Madison Ave
New York, NY 10016-0601

by placing same in an envelope, properly sealed and addressed, with postage prepaid and depositing same with the United States Postal Service on this 1ST day of June, 2011.

/s/ Brian McGinley
Brian McGinley

Filed with the TTAB via
ESSTA on June 1, 2011